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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,605	12/23/2003	Wee Song, Steve Loy	BCONP2003-13	1604
31366	7590	06/03/2010	EXAMINER	
HORIZON IP PTE LTD 7500A Beach Road #04-306/308 The Plaza SINGAPORE 199591, SINGAPORE			JARRETT, RYAN A	
			ART UNIT	PAPER NUMBER
			2121	
			NOTIFICATION DATE	DELIVERY MODE
			06/03/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/707,605	Applicant(s) LOY ET AL.	
	Examiner RYAN A. JARRETT	Art Unit 2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 12-15 and 21-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 12-15 and 21-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/04/10 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 12-15, and 21-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1, 26, and 35 each recite “providing at least one generic interface unit communicative coupled *between the hub-box* and an automated device” (emphasis added). This is not supported by the specification, in Fig. 1 for example. In Fig. 1, the hub-box is represented by numeral 101, the hub is represented by numeral 106, and the generic interface unit(s) is

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represented by numeral 108, and the automated device(s) is represented by numeral 104. So, as depicted in Fig. 1, the generic interface unit is communicatively coupled *between the hub 106* and the automated device 104 (emphasis added). The generic interface unit cannot be coupled between the hub-box and the automated device since the generic interface unit 108 is part of the hub-box 101.

Claims 12-15, 21-25, and 27-35 depend from claims 1, 26, and 35 and incorporate the same deficiencies.

Correspondingly, in claims 12 and 28, it appears that the “hub-box” should be changed to “hub”.

And in claims 15 and 31, it appears that it should be the “generic interface unit” doing the “detecting” and “translating”, not the “hub-box”. Correction and/or clarification is required.

Response to Arguments

Applicant’s arguments, see pages 8-10, filed 05/04/10, with respect to the rejection(s) of claim(s) 1, 12-15, and 21-25 under 35 U.S.C. 102(b) as being anticipated by Andrews et al. US 6,456,955 have been fully considered and are persuasive to the extent that Andrews et al. does not teach “providing at least one generic interface unit communicatively coupled between the hub-box and an automated device, wherein said generic interface unit comprises a plurality of communication links employing different communication protocols”, as currently recited in claim 1. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Margrey et al. US 5,366,896.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 12, 15, 21-26, 28, 31-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Margrey et al. US 5,366,896.

For example, Margrey et al. discloses:

1. A method of automating validation comprising:

defining requirements (e.g., claim 1 step z: *there must be a requirement in order to issue an acceptance or rejection*);

selecting automated devices for manufacturing (e.g., claim 1);

integrating the automated devices in a production line (e.g., claim 1, col. 3 lines 20-24), wherein integrating the automated devices comprises interconnecting the automated devices to a hub-box via communication links, the hub-box operationally controls and facilitates communication between automated devices and validation of the manufacturing process (e.g., col. 16 lines 3-47, col. 20 lines 15-29), wherein the validation includes generating an organized set of documents, defining aspects of the process, in conformance with regulatory standards (e.g., claim 1 step z);

providing at least one generic interface unit communicatively coupled between the hub-box and an automated device, wherein said generic interface unit comprises a plurality of

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communication links employing different communication protocols (e.g., col. 16 lines 3-47, col. 20 lines 15-29);

collecting processing data from the automated devices by the hub-box for analysis (e.g., claim 1 step z);

analyzing processing data to determine whether the requirements are satisfied (e.g., claim 1 step z); and

validating the manufacturing process if the requirements are satisfied (e.g., claim 1 step z).

12. The method of claim 1 further comprises communicating, by the generic interface unit, with the automated device using a first communication protocol and communicating, by the generic interface unit, with the hub-box using a second communication protocol (e.g., col. 16 lines 3-47, col. 20 lines 15-29).

15. The method of claim 12 further comprises:

detecting, by the hub-box, the first communication protocol; and

translating, by the hub-box, instructions or information so that the hub-box can communicate with the automated device (e.g., col. 16 lines 3-47, col. 20 lines 15-29).

21. The method of claim 1 wherein the requirements are user requirements or functional requirements (e.g., claim 1 step z).

22. The method of claim 21 wherein the user requirements are facility operating conditions, desired output, quality, process or product specifications (e.g., claim 1 step z).

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23. The method of claim 21 wherein the functional requirements are power consumption, loading, speed or capacity, environmental operating conditions, system or equipment functionalities, process results or quality parameters (e.g., claim 1 step z).

24. The method of claim 1 wherein the documents contain information relating to change history, operating conditions, events, alarm messages, control parameters, process parameters, measurement data or analysis results (e.g., claim 1 step z).

25. The method of claim 1 wherein the documents are audit trail reports, electronic records or electronic signatures (e.g., claim 1 step z).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13, 14, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Margrey et al. as applied to claims 1 and 28 above, and further in view of Official Notice.

Margrey et al. does not disclose the specific protocols recited in claims 13, 14, 29, and 30.

Examiner takes Official Notice that these protocols are well-known in the art of host-controlled and host-monitored manufacturing and/or test environment, wherein protocols are converter exists between the host and the equipment.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Margrey et al. with Official Notice since all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. See *KSR v. Teleflex*, 127 S.Ct. 1727 (2007).

Allowable Subject Matter

Claims 35 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action.

Claim 27 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 1 and 26 would also be allowable if Applicant changed all instances of “automated devices” in these claims and their dependents to “automated manufacturing devices”. As it stands now, the language is broad enough to read on analytical devices and other equipment used for manufactured products.

If Applicant makes these changes then the case be passed to issue.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under

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37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN A. JARRETT whose telephone number is (571)272-3742. The examiner can normally be reached on 10:00-6:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ryan A. Jarrett/
Primary Examiner, Art Unit 2121

05/27/10